



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,459	09/08/1999	HEIZO KITAJIMA	33701M002	8638

7590

03/27/2002

SMITH GAMBRELL & RUSSELL LLP  
BEVERIDGE DEGRANDI WEILACHER & YOUNG  
INTELLECTUAL PROPERTY GROUP  
1850 M STREET NW SUITE 800  
WASHINGTON, DC 20036

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/391,459

Applicant(s)

KITAJIMA, HEIZO

Examiner

James Zurita

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment: See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Application of 8 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al., US Patent 5,974,396.

As per claim 1, Anderson et al. discloses a client card mail system comprising:

- (a) means for storing client information including individual information of clients' code number, name, sex distinction, age, address and telephone number (see at least Col. 3, lines 9-29; Col. 8, line 44-Col. 10, line 30 for references to client/consumer information);
- (b) means for storing information of the goods for sales company for the sales goods, departments, classes of the goods name, goods codes, prime unit prices and sales unit prices (see at least Col. 2, line 56- Col. 3, line 8; Col. 8, lines 11-46);
- (c) means for storing information of the goods purchased by the clients (see at least Co. 10, lines 31-46 for client/consumer historical and transactional information) and
- (d) means for retrieving clients' information of the clients who actually purchased the goods setting the conditions of periods and goods classes from the information of the goods purchased (see at least Col. 10, line 46-Col. 6, line 5, describing retrieval of information using SQL); and
- (e) means for outputting and printing the results retrieved, thereby to enable useful propaganda activity of the sales goods (see at least references to Print Systems Analysis and Print Intelligence databases; see also Col. 4, lines 19-49, Col. 11, line 31 – Col. 12, line 26).

As per claim 2, Anderson et al. discloses the client card main system according to claim 1, wherein (a) said means for storing client information, (b) said means for storing goods information and ( c ) said means for storing goods sales information comprise a recording medium such as a magnetic card, a plurality of terminal devices, a main computer, and a data storing device (see at least Col. 8, line 21-Col. Col. 24, line 13, which describe recording and storage of information in relational databases, types of storage media and files).

As per claim 3, Anderson et al. discloses the client card mail system according to claim 1, wherein said means for retrieving client information comprises a plurality of terminal devices and a main computer (see at least Col. 4, lines 19-49; Col. 7, line 5-Col. 8, line 14).

As per claim 4, Anderson et al. discloses the client card mail system according to claim 1, wherein said means for outputting and printing the retrieved result comprises a printer and a card issuing machine (see at least Col. 10, line 46-Col. 6, line 5, describing retrieval of information; see at least references to Print Systems Analysis and Print Intelligence databases; see also Col. 4, lines 19-49, Col. 11, line 31 – Col. 12, line 26).

As per claim 5, Anderson et al. discloses a client card mail system comprising the steps of

- (a) setting a purchase time of the goods advertised to a main computer (see at least Col. 11-30, Fig. 9 and references to timer interval for consumer behavior reports, see at least Col 14, lines 49-60),

- (b) selecting a class where the retrieval is made by a company, a department or the good (see at least Col. 2, line 46-Col. 3, line 7, Col. 10, line 46-Col. 6, line 5) and
- (c) carrying out the retrieval in the selected class (see at least Col. 12, lines 10-40);
- (d) reading and displaying a retrieval result on the screen (see at least Col. 9 lines 3-19);
- (e) outputting the retrieval results read and displayed on the screen (see at least Col. 9, lines 3-19); and
- (f) performing printing (see at least Col. 4, lines 34-49, Col. 11, lines 31-40); .

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-395-3900.

**James Zurita**  
**Patent Examiner**  
**Group Art Unit 2165**  
March 22, 2002

JZ